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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/959,013 10/28/97 O'MALLEY

B 226/286

EXAMINER

HM22/0331

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SHUKLA, R

ART UNIT

PAPER NUMBER

1632

DATE MAILED:

03/31/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/959,013

Applicant(s)  
Bert O'Malley et al

Examiner  
Ram Shukla

Group Art Unit  
1632



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-40 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Claims 1-40 are pending in the instant application.

***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, 32-40, drawn to a receptor, classified in class 530, subclass 350.
  - II. Claims 11-19, 30, 31, drawn to a nucleic acid, vector, host cells and methods of using host cells, classified in class 536, subclass 23.1.
  - III. Claims 20-23, and 28, drawn to a method of treatment, classified in class 514, subclass 44.
  - IV. Claims 24-28, drawn to a method of treatment, classified in class 514, subclass 44.
  - V. Claim 29, drawn to a transgenic animal, classified in class 800, subclass 8.
3. The inventions are distinct, each from the other because of the following reasons:

The inventions of the groups I and II are patentably distinct from each other because they have different compositions, physical and chemical properties, and chemical structures and can be prepared by different methods. For example, a receptor can be purified from a tissue or a recombinant cell expressing the said receptor. Likewise, a nucleic acid, expressing a receptor, can be modified to produce different levels of the receptor as well as receptors with different binding properties. Therefore, the inventions of the groups I and II will require different considerations of search, for example in the non-patent literature.

The inventions of the groups I, II and V are patentably distinct each from the other because the parameters and considerations to make a transgenic animal expressing a nucleic acid are distinct compared with the considerations of expressing the nucleic acid in a cell or the receptor encoded by the nucleic acid and therefore will require separate searches in the non-patent literature.

The inventions of the groups III and IV are drawn to *in vivo* methods of treatments of diseases, arthritis and asthma respectively. The inventions of the groups III and IV patentably different each from the other because they are drawn to the methods of treatment of different diseases and therefore, will require different considerations of searches and analysis, such as the particular disease, their mechanisms of development, and their symptoms, in the non-patent literature.

The inventions of the groups II-IV are patentably distinct each from the other and also from the inventions of each of the groups I and V because the inventions of the groups II-IV are drawn to methods of making host cells, a method of treating arthritis and a method of treating asthma respectively whereas the inventions of the groups I and V are drawn to proteins and transgenic animals respectively. As stated above, the parameters of searching the method of producing a host cells expressing a protein or parameters of searching the method of treating a disease are different from search parameters used for analyzing a protein, a nucleic acid or a transgenic animal.

4. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

5. A telephone call was made to Mr. Charles S. Berkman on 3/15/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

Serial No. 08/959013  
Art Unit 1632

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Stanton, can be reached on (703) 308-2801. The fax phone number for this Group is (703) 308-8724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

A handwritten signature in black ink, appearing to read "B. Stanton", written in a cursive style.

**BRIAN R. STANTON, PH.D**  
**PRIMARY EXAMINER**

Ram R. Shukla, Ph.D.  
March 19, 1999